



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/367,712 08/18/99 SEFTON

J 17224 (AP)

ROBERT J BARAN  
ALLERGAN SALES INC  
2525 DUPONT DRIVE T2 7H  
IRVINE CA 92612

HM12/0301

EXAMINER

RADIO, B

ART UNIT	PAPER NUMBER
----------	--------------

1616

DATE MAILED:

03/01/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
09/367,712

Applicant(s)

Sefton

Examiner

Barbara Badio

Group Art Unit

1616



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1616

### **First Office Action on the Merits**

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto ('906) and Nagpal et al. ('279) in combination.

Yamamoto teaches it is known in the art to use adrenocortical hormones, such as fluocinolone acetonide, betamethasone valerate and clobetasol propionate, in the treatment of skin diseases such as psoriasis and atopic dermatitis (col. 1, line 11 - col. 2, line 55).

Nagpal et al. teach it is known in the art to use tazarotene in the treatment of psoriasis (col. 1, lines 42-47).

The instant claims differ from the cited references by reciting the combined use of a corticosteroid and tazarotene in the treatment of skin diseases such as psoriasis. However, it is known in the art as indicated above to use each of the recited compound in the treatment of psoriasis. The combination of two compounds/compositions taught

Art Unit: 1616

by the prior art to be useful for the same purpose to form a third composition that is to be used for the very same purpose would have been obvious to one having ordinary skill in the art. In re Kerkhoven, 205 USPQ 1069 (CCPA 1980). Thus, the claimed composition is prima facie obvious based on the combined teachings of the above references. The ordinary artisan would be motivated to use combination treatment for a number of reasons including the reduction of the adverse effect of each of the compound utilized.

Claims 3, 7 and 8 further differ from by reciting specific pharmaceutical formulation containing 0.1% tazarotene.

However, the preparation of various formulation containing various amounts of the active ingredients for topical use is within the level of skill of one having ordinary skill in the pharmaceutical art and, thus, is within the level of skill of the ordinary artisan. In addition, finding the optimum amount of the active ingredient useful in the treatment of said disorder is also within the level of skill of the ordinary artisan and it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

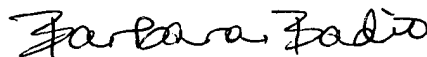
Art Unit: 1616

***Telephone Inquiry Contacts***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Badio whose telephone number is (703) 308-4595. The examiner can normally be reached between 7:30 am and 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, José Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
Barbara Badio  
Art Unit 1616

February 28, 2000